APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,985	11/30/2000	David M. Morlitz	POU9-2000-0027-US1	2120

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EXAMINER
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ART UNIT	PAPER NUMBER
2177	8

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Advisory Action	Application No.	Applicant(s)
	09/726,985	MORLITZ, DAVID M.
	Examiner	Art Unit
	Miranda Le	2177

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11/12/03 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

    (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

    (b) ☐ they raise the issue of new matter (see Note below);

    (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

    NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: *None*.

Claim(s) objected to: *None*.

Claim(s) rejected: *2-5, 7, 8, 10-14, 20-28, 35-38, 40, 41, 43-47, 53-58, 68-71, 73, 74, 76-80 and 86-88*.

Claim(s) withdrawn from consideration: *None*.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____
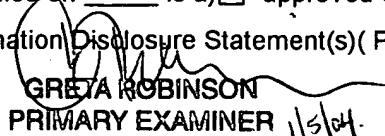
GRETA ROBINSON
PRIMARY EXAMINER 1/5/04.

Miranda Le
December 5, 2003

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' arguments do not overcome the final rejection. Please see attachment.

With regard to claim 7, Applicant's arguments are not persuasive. The Examiner has thoroughly reviewed Applicants' arguments but firmly believes that the cited reference reasonably and properly meet the claimed limitation. Applicants are reminded that the Examiner is entitle to give the broadest reasonable interpretation to the language of the claimed as explained below. The Examiner is not limited to Applicants' definition which is not specifically set forth in the claims. In re Tanaka et al., 193 USPQ 139, (CCPA) 1977.

Applicant states that the combination of references suggested by the Examiner does not teach or suggest the limitations of claim11. The Examiner respectfully disagrees. Leak teaches "receiving a single request from a client computer, the single request identifying a desired Web page" at col. 7, lines 34-36, that is, the client system 1 initially receives a Web page (i.e., the top level Web page). The Web page may be received in response to the user of the client system 1. It should be understood that after the client system received a Web page in response to a user (or a single request from a client computer), the client system is able to identify URIs based on the tags in an HTML document (col. 7, lines 39-40). Next, the client system 1 uses the identified URI to request and receive each of the Web pages that are directly linked to the current Web page (i.e., the second Web pages) (col. 7, lines 40-43). This step also corresponds to the step of "generating a site map".

Leak teaches "generating a site map including the desired Web page" at col. 7, lines 40-44, col. 8, lines 55-61, that is, in Fig. 10, N represents a current level within a Web page hierarchy for a given Web site. Thus, N=1 corresponds to the top (root) level,

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or home page, of the given Web site. It should be noted that the URI list (i.e., a site map) is generated based on the home page as the root level in the hierarchy. This home page may be received in response to the user (col. 7, lines 35-36). It should be noted that "the top level Web page" corresponds to the home page, or a desired Web page based on the user requests.

Leak teaches "restricting a scope of the site map" at col. 7, line 1 to col. 8, line 54;

Leak does not specifically teach "sending an archive file containing the site map to the client computer in response to the single request". However, Chen teaches this limitation at col. 4, lines 1-62.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Leak with the teachings of Chen to include "sending an archive file containing the site map to the client computer in response to the single request" in order to enable users to retrieve and search through old information, even after such information has evolved or disappeared from the original server.

In addition, in response to the preceding arguments, the Examiner respectfully submits that the combination of Leak and Chen et al. would satisfy the limitation of claim 11. It has been held that the fact that Applicant as recognized another advantage, which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, Applicant has recognized that Leak is directed to making web browsing more like watching television by allowing a user to view a sequence, or tour, or Web page without having to specifically locate or request each individual Web page. In contrast, pursuant to Applicant's specification (see

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page 3, lines 1-6), to provide providing resources from a web server to a client computer, the Web server identifies a plurality of resources associated with the desired Web page and sends an archive file containing the plurality of resources to the client computer. Examiner accordingly has pointed out that Leak teaches a method of displaying World Wide Web pages on a display device (Abstract), Leak discloses that in response to the user of the client system 1, a Web page may be received (i.e., receiving a single request from a client computer, the single request identifying a desired Web page) (col. 7, lines 34-36); Leak discloses the client system 1 uses the identified URIs (i.e., a site map) to request and receive each of the web pages that are directly linked to the current Web page (col. 7, lines 41-43) wherein relevance of a Web page may be determined based on how closely the contents of the Web page match the user's specified search criteria (col. 9, lines 48-50) (i.e., generating a site map including the desired Web page) . It should be noted "the client system 1 uses the television set 12 as a display device (i.e., a monitor) (col. 3, lines 66-67), and "a tour of Web pages" is based on the list of URIs as in "a site map". Further, Chen complements Leak by teaching the step of sending an archive file containing the site map to the client computer in response to the single request. One of ordinary skilled in the art would find it obvious to modify Leak in view of Chen in order to enable users to access the Web page and link to other Web pages without a network connection (col. 8, lines 24-28), and to retrieve and search through old information, even after such information has evolved or disappeared from the original server (Abstract). It is therefore respectfully submitted that even though the Applicant has recognized another advantage, which is provided by the references and which seems to be different from the

one noted by the Examiner, such disparities by themselves do not make the invention patentable over the prior art of record.

Furthermore, Applicant's arguments seem to be suggesting that there is no suggestion to combine the references. In response to the preceding arguments, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a method for providing resources from a Web server to a client computer of the present invention reads on Leak's teaching of generating site map including the desired Web page at col. 7, lines 34-36, col. 8, lines 55-56. Leak teaches a site map is stored in memory of a client system (col. 8, lines 63-63), but does not expressly teach sending an archive file containing the site map to the client computer. However, Chen teaches this limitation at col. 4, lines 1-62. Both Leak and Chen teach the same field as retrieving the desired Web page and linking to another Web pages in the hierarchy, hence, the combination of Leak and Chen would arrive at claim 11 of the present invention since Chen would enable users to access the Web page and link to other Web pages without a network connection (col. 8, lines 24-28), and to retrieve and search through old information, even after such information has evolved or disappeared from the original server (Abstract).

Applicant has made a piecemeal analysis of the references. Applicant is therefore reminded that one cannot show nonobviousness by attacking references individually

where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986).

Accordingly, the claimed invention as represented in the claims does not represent

a patentable over the art of record.

Miranda Le
January 5, 2004